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level repository.

43. (New) The computing system as in claim 41, wherein each of the first party's personal information objects is assigned at least one of a plurality of security clearance levels, whereby the at least one of the plurality of security clearance levels enables access to individually selected portions of the first party's personal information.

Remarks

Applicants have carefully reviewed the Examiner's Final Office Action dated August 18, 2000. This preliminary amendment is believed to address all issues raised by the Examiner including all grounds of rejection raised by the Examiner's Action.

Information Disclosure Statements

In view that the Applicants have filed a Request for Continued Examination concurrently herewith, all previously submitted information disclosure statements are believed to be in a condition for entry without a need for any petition or additional fee. Examiner is respectfully requested to examine them and enter them prior to examining this Application.

Amendment to the Specification

Certain English language errors are corrected in the Specification. No new matter is added as a result of these corrections. Examiner is requested to review these corrections and enter them.

Amendment to the Claims

Claims 1, 5, 14, 19, 22–23, 25–26, and 28 are amended to change the noun "user"

to a more descriptive noun "first party", the noun "requester" to a more descriptive noun "receiving party" and further to describe how the plurality of security levels allow access to selected portions of the first party's personal information.

These changes are made in order to state the invention more clearly and not in response to any rejection by the Examiner. Examiner's rejections based on obviousness under 35 U.S.C. §103(a) are addressed below. No new matter is added as a result of this amendment. Examiner is respectfully requested to enter these corrections.

Claim 25 is further amended to modify the word "levels" to --level(s)-- to state the invention more clearly. This change does not add any new matter.

Claims 26–30 are amended to recite claims directed toward a program storage device rather than computer-executable "code" in order to comply with In re Beauregard. It is believed that no new matter is added as a result of these changes.

Addition of New Claims

New claims 31–43 are added in this Preliminary Amendment. These include 6 new independent claims. It is believed that a fee of \$793 is due under 37 C.F.R. §1.17(i). A new fee determination record is enclosed in duplicate. A check for \$793 is enclosed.

Claim Rejection under 35 U.S.C. §101

As stated above, Applicants amended the cited claims to comply with In re Beauregard to overcome this rejection. Reconsideration is respectfully requested.

Claim Rejection under 35 U.S.C. §112, First Paragraph

Examiner rejected claims 26–30 under 35 U.S.C. §112, First Paragraph, stating that the specification did not show what "code" the Applicants had in their possession as of the filing date of the application. First, Applicants submit that the amended claims 26–30 do not include the "code". In view of these changes, Applicants request reconsideration.

Additionally, Applicants traverse this rejection on grounds that there was an abundance of written description to enable the program storage device as claimed. Numerous indicia of actual implementation are provided in the Application. Examiner cited that there existed description of software modules to perform different and specific functions. Examples of programming languages that could be used to create these modules are specified, and a clear direction as to the type of general purpose computer that could be programmed using the programming languages to create the functionality is also described. Applicants submit that this description is adequate to instruct a person of ordinary skill in the art to make and use the program storage device configured according to the principles of the claimed invention.

Moreover, in the case of software, the required structure need not be physical structure, but can be a particular algorithm performed by a general purpose computer. See WMS Gaming Inc. v. International Game Tech., 184 F.3d 1339 (Fed. Cir. 1999). A general purpose computer, or a microprocessor, can be programmed to carry out an algorithm, which "creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software." See id. (citing In re Alappat, 33 F.3d 1526, 1545, 31 U.S.P.Q. 2D (BNA) 1545, 1558 (Fed. Cir. 1994) (*en banc*)). "The instructions of the software program that carry out the algorithm electrically change the general purpose computer by creating electrical paths within the device. These electrical paths create a special purpose machine for carrying out the particular algorithm....." See id.

Furthermore, "[35 U.S.C. Section 112,] Paragraph 1 permits resort to material

outside of the specification in order to satisfy the enablement portion of the statute because it makes no sense to encumber the specification with all the knowledge of the past concerning how to make and use the claimed invention." Atmel Corp. v. Information Storage Devices, 198 F.3d 1374, 1382, 53 U.S.P.Q. 2D (BNA) 1225, 1999 U.S. App. LEXIS 34441, **20, 22–23 (Fed. Cir. 1999). In view of the foregoing, Examiner is respectfully requested to reconsider his rejection of claims under 35 U.S.C. §112, First Paragraph.

Claim Rejection under 35 U.S.C. §112, Second Paragraph

Examiner rejected claims 26–30 as being indefinite citing that the term code was "vague." As stated earlier, Applicants have redrafted the claims 26–30 to overcome this rejection as well as the rejection under 35 U.S.C. §101. Reconsideration is respectfully requested. "Code" has been more clearly claimed as "program storage device" comprising "program of instructions" executable by a processor. As stated above, there is sufficient enabling written description to meet the statutory requirements.

Claim Rejection under 35 U.S.C. §103(a)

Examiner rejected claims 1–5, 14–16 and 24–30 under 35 U.S.C. §103(a) as being unpatentable over Perry et al. (USP 5,241,466) in view of Smith (4,956,769). Applicants respectfully assert that the Examiner did not meet his initial burden of factually supporting a *prima facie* conclusion of obviousness under 35 U.S.C. §103(a).

To show a *prima facie* case of obviousness, there must first be a showing of motivation, or suggestion *outside of Applicant's disclosure* to combine the references in order to make the claimed invention. Examiner did not show any relationship between the systems proposed by Perry, Smith, Vaudreuil or Murphy and the present invention, nor did the Examiner identify a specific problem which would have motivated a person skilled in the art to combine any of these references. Additionally, the Examiner

provided no technological reason whatsoever to select the references cited, especially in view of the fact that the references identified by the Examiner fall into non-analogous arts. See M.P.E.P. §2141.01(a). Applicants request the Examiner to note that Perry belongs to class 705/1; Smith falls under 707/9; Vaudreuil is classified as being under 370/60; and Murphy is categorized as belonging to 713/201. See Notice of References Cited in Examiner's First Office Action dated April 18, 2000; Examiner's Final Office Action dated August 10, 2000.

Moreover, the Examiner did not show what level of ordinary skill was considered to reject the pending claims under 35 U.S.C. §103. Clearly this does not meet the burden on the Examiner of producing a "clear and particular" case of combinability of references. See Ecolochem v. Southern California Edison, Case No. 99-1043, available at <ftp://ftp.fedcir.gov/fedcir.gov/99-1043.exe> (Fed. Cir. Sept. 7, 2000) (citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") (citing C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q. 2d 1225, 1232 (Fed. Cir. 1998))).

Applicants respectfully remind the Examiner that "[m]ost, if not all, inventions are combinations and mostly of old elements." See Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 U.S.P.Q. 8, 12 (Fed. Cir. 1983). "Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" See In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q. 2d 1453, 1459 (Fed. Cir. 1998) (citing Sensonics, Inc. v. Aerasonic Corp., 81 F.3d 1566,

1570, 38 U.S.P.Q. 2d 1551, 1554 (Fed. Cir. 1996)).

A teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, *and not based on applicant's disclosure*. See M.P.E.P. §2142 (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991)). (Emphasis added). Absent motivation or suggestion to combine, one of ordinary skill in the art would not have viewed the instant claimed invention as obvious. See In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q. 2d 1453, 1459 (Fed. Cir. 1998).

Before traversing each rejection under 35 U.S.C. §103(a) individually and with particularity, Applicants hereby generally traverse all obviousness rejections made by the Examiner. For those rejections in which the Examiner appears to have taken official notice, Applicants demand a production of adequate basis for taking such notice under M.P.E.P. §2144.

A. Rejection under 35 U.S.C. §103(a) – Perry in view of Smith

Examiner has once again rejected claims 1–5 under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Smith. Additionally, Examiner rejected claims 14–16, 19–21, and 24–30 under 35 U.S.C. 103(a) as being unpatentable over Perry et al. in view of Smith. Applicants respectfully disagree with the Examiner that such a combination would have been obvious.

As Applicants pointed out in their response to the First Office Action, neither Perry nor Smith, either individually or in combination provides a case of *prima facie* obviousness. Perry is directed toward a central depository for living wills. Smith is directed toward an occurrence level, value based security system. Examiner incorrectly reasoned that because Smith disclosed a plurality of terminal devices, it followed that

there were a plurality of security clearance levels. Applicants respectfully assert that such a result is not warranted by the language used in Smith.

Further, the instant invention claimed the step of "assigning at least one of a plurality of security clearance levels to each information object," which is not the same as what is disclosed in Smith. Thus, as Applicants stated in their response to the First Office Action, the particular combination of steps claimed in the instant invention, in particular, the step of "assigning at least one of a plurality of security clearance levels" is not disclosed either in Smith or in Perry.

Moreover, neither of these references is in the art pertinent to the present invention, which is directed toward an online repository for personal information, whereby a user stores in a central database his personal information such as address, credit card information, travel preferences, and preserves privacy of the information while providing access to selected portions of this information to requesters on a need-to-know basis.

Examiner appears to rely solely on a general statement in Smith that the trend, in 1988 when Smith filed for his patent, was "to assign computers more of the chores of managing our personal and business activities. Computers are routinely handling the most sensitive correspondence. For example, electronic funds transfer systems pass our money around the globe in bit streams, and sensitive governmental communications are sent among various departments by computer networks." See Smith, at Col. 1, lines 24-31. This general statement neither expressly nor implicitly would have taught a person skilled in the art the desirability of using a system to store and disseminate user's personal information to requesting entities as in claim 1. Such a general motivational statement based on hindsight is improper. See Formulating and Communicating Rejections Under 35 U.S.C. §103 for Applications Directed to Computer-Implemented Business Method Inventions, Example 17, available at <<http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm#E17>>.

There are three possible sources for a motivation to combine references: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. See In re Rouffet, 149 F. 3d 1350, 47 U.S.P.Q. 2d 1453 (Fed. Cir. 1998). Applicants respectfully submit that in none of the three possible sources, outside of the Applicants' disclosure, could one find a motivation to combine Smith with Perry to achieve the present invention.

1. The nature of the problem to be solved

Examiner stated that the Perry system could be combined with the Smith protection scheme for database access from specified terminal locations for input/output operations. In particular, Examiner argued that Smith disclosed the act of "assigning at least one of a plurality of levels" to each personal information object.

In order to combine these two references, Examiner stated that a mere allusion, in Smith, to the trend of using computers to perform personal "chores" implied a desirability to combine Smith with Perry to arrive at the presently claimed invention. A party asserting obviousness cannot simply "pick and choose among the individual elements of assorted prior art references to recreate the claimed invention." See SmithKline Diagnostic, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 887 (Fed. Cir. 1988).

Even if one assumes, *arguendo*, that this piecemeal combination showed all the limitations in the instant claims, *unless the Applicants' disclosure is used as a blueprint*, Perry and Smith do not show what "specific understanding or technical principle . . . would have suggested the combination." See In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q. 2d 1453, 1459 (Fed. Cir. 1998); see also Ecolochem v. Southern California Edison, Case No. 99-1043, available at <ftp://ftp.fedcir.gov/fedcir.gov/99-1043.exe> (Fed. Cir. Sept. 7, 2000). In other words, the glue that binds the claim limitations still needs to be shown by the Examiner. In view of the above, Applicants submit that this is

an exercise of impermissible hindsight by the Examiner.

That the Examiner has used the Applicants' disclosure as a blueprint may be evidenced from the fact that though Perry was directed toward a central depository for storing living wills, durable powers of attorney, entering legislative information to track changes in laws, storing the user's address to determine which state law applies to the user's living will, periodically entering legislative review information, periodically verifying the legal sufficiency of said documents in response to said legislative review information, organ donor information and the like, Examiner incorrectly stated that the numerous categories of personal information, *viz*, contact information; health-related information; medical, dental information; credit/employment information; insurance information; property-related information; personal demographic information; family medical history; biometric/genetic information; travel/hotel preferences; internet preferences; sartorial, fashion preferences; magazine, movies, book preferences; leisure preferences; preferences for billing or payment methods, or pleasure-related preferences are all obvious in view of Perry. See Final Office Action dated August 18, 2000, rejecting claim 19.

As explained by the Applicants in the sections entitled "Background", "Summary" and "Detailed Description," in one aspect, the present disclosure attempts to alleviate a web surfer's annoyance. When a user visits web sites, he is burdened with entering repetitive personal information, which is solved by the present invention by storing all user's personal information in a centrally located repository for use by designated entities. Further, a novel method of classifying personal information is disclosed and claimed, whereby requesters of the user's personal information receive a previously authorized portion of the user's personal information. This method ensures privacy of the user's personal information while allowing it to be shared with various parties such as a doctor, dentist, tailor, mortgage company and others on a need-to-know basis. A complex method is disclosed herein whereby certain selected portions of the user's personal information are divulged to a requesting party. In alternative embodiments, the disclosure contemplates the following components: a trusted computer base, a distributed

architecture, a multi-level database, data encryption schemes, explicit declaration of security policy, authorization keys, secure kernel, and a secure audit trail of all transactions.

Using the method disclosed, a user can direct a requester such as a doctor's office or a travel agent to obtain that portion of the information which is pertinent for that requester and that which is authorized by the user for that requester. To accommodate this, the present invention discloses two aspects: a first aspect is the plurality of security clearance levels, each of which of the plurality of security clearance levels being assigned to each information object at any level of granularity; and a second aspect is that the requester of information may specify the type of information he wishes to access. When this request arrives at the server, a security clearance level is assigned to the requester's request, which is subsequently examined to determine (1) if the requester is authorized to receive any information at all; (2) if the requester is authorized to receive all of the information he is requesting; and (3) if not, then what subset of information may be transmitted to the requester. In another aspect, a designated entity will automatically receive authorized information.

In another aspect, the present disclosure is directed toward assisting a user in not having to fill-out numerous forms at a doctor's office with routine, laborious, redundant, repetitive personal information in a time-consuming manner by storing personal information in a single database coupled to the Internet, thereby using the Internet as an enabling mechanism. This system helps the user by projecting a portion of his electronic personality depending on the role he plays at any given time, for example, as a busy business traveler who wants to reserve a flight or book a hotel room. Contact information and other personal information (choice of airplane seat, credit card number, or information typically stored in a gentleman's wallet) is given out to an online business entity, a travel agent, or a hotel clerk on a need-to-know basis. No prior art systems have this flexibility. See In re Zurko, 111 F.3d 887, 890 (Fed. Cir. 1997) (stating "to say that the missing step comes from the nature of the problem to be solved begs the question because the Board has failed to show that this problem had been previously identified

anywhere in the prior art"); see also In re Sponnable, 405 F.2d 578, 585 (C.C.P.A. 1969) ("[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified."); In re Wright, 848 F.2d 1216 (Fed. Cir. 1988) (differences between the problem solved by the invention and those solved in the prior art may defeat the rejection); In re Shaffer, 229 F.2d 476 (C.C.P.A. 1956) (lack of identification of the problem facing the inventor is basis for finding that references could not have suggested a solution to the problem). Even simplicity of an invention of itself does not negative patentability. See In re Oetiker, No. 91-1026, slip. op. at 5 (Fed. Cir. Oct. 13, 1992) (citing Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 279, 60 U.S.P.Q. 386, 388 (1944); see also Panduit Corp. v. Dennison Mfg Co., 810 F.2d 1561, 1572, 1 U.S.P.Q. 2D (BNA) 1593, 1600 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987) ("the patent system is not foreclosed to those who make simple inventions")).

In contrast to the innumerable Internet business entities, the present invention makes it possible to use the Internet as an application development platform and a communication method to deliver a party's personal information automatically. Some advantages inherent to this disclosed method include the following: information can be updated by a doctor, and the updated information can be stored in a centralized online repository upon proper authorization by the user, portions of which updates can be securely transmitted upon authorization by the user in an automatic way to entities such as insurance companies for approval of certain medical procedures. Another advantage is that the user can specify address changes and the like at one central place, and set a predetermined time at which these changes can be transmitted automatically to authorized entities. This resolves the following problem faced by an attorney: the various state Bars and other registering agencies such as the PTO require all practitioners to notify address changes within a 30-day period. By automating this notification procedure, an attorney can concentrate on his clients' tasks rather than tending to these routine needs. See e.g., In re Wright, 848 F.2d 1216, 1219 (Fed. Cir. 1988) (stating "[f]actors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness" in terms of

35 U.S.C. §103.). This could achieve an automatic, paperless authorized transmittal of personal information while preserving privacy of the individual whose information is being transmitted.

2. The teachings of the Prior Art

Applicants respectfully submit that the evidence that there is no motivation to combine Smith with Perry to achieve the present invention may also be seen with the PTO classifications. For instance, the Smith patent has been referenced or cited by others 31 times, as indicated by the online PTO database. In none of these multifarious variations did any inventor propose to combine a centralized personal information repository that allows assignment of security classifications to each information object so that at least some information objects could be disbursed to an authorized entity as claimed herein. This alone is ample proof that a person with skill in the art would not have achieved the invention as described and claimed in the instant application. In the previous 8 years, 8 issued patents referenced Perry, including one that was filed as recently as 1997, and not one of these 8 patents that referenced Perry also referenced Smith.

Moreover, there are no drawbacks to the inventions of Smith or Perry, which drawbacks might have suggested some desirability to combine the two references. It is very respectfully reminded that a proper determination under 35 U.S.C. §103(a) requires that the Examiner must step *backward in time and into the shoes worn by a person of ordinary skill in the art* when the invention was unknown and just before it was made. See MPEP §2142. (Emphasis added).

3. The knowledge of persons of ordinary skill in the art

"When determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to

suggest the desirability, and thus the obviousness, of making the combination.'" See In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q. 2d 1453, 1459 (Fed. Cir. 1998) ((citing In re Beattie, 974 F.2d 1309, 1311–12, 24 U.S.P.Q. 2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984))).

Examiner is requested to provide some guidance of what, in Examiner's view, was the pertinent art, especially in view of the PTO's classification of art groups. As stated earlier in the general traversal, the PTO classification system, which is relied upon by the Examiner to impose a restriction requirement in the instant case, reveals that the inventions disclosed and claimed by Perry and Smith belong to separate and distinct art groups: Perry belongs to class 705/1, whereas Smith is classified under 707/9. See Notice of References Cited, enclosed with the First Office Action dated April 18, 2000. There is no overlap between Smith and Perry to even suggest that there could be a desirability to combine the references. Thus, it is clear that prior to Applicants' filing of the instant application, there had been no plausible motive for a person skilled in the art to consider that Smith and Perry as being in the same art, much less a desire to combine them to achieve the instant claimed invention.

Applicants submit that a mere assertion, *which could be an unstated official notice taken by the Examiner*, that it would have been obvious to a person of ordinary skill in the art is insufficient, and respectfully demand the Examiner to produce evidence substantiating this official notice under M.P.E.P. §2144.03. In view that Examiner did not provide an indication of the pertinent art, and a level of skill of an ordinary person skilled in the art, Applicants traverse this rejection on grounds that a *prima facie* case of obviousness is not shown by the Examiner.

Secondary Considerations

Based on the foregoing reasons, it is respectfully reiterated that an absence of a

teaching to combine is "dispositive in an obviousness determination." See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F. 3d 1573, 1579, 42 U.S.P.Q. 2d 1378, 1383 (Fed. Cir. 1997). Examiner is respectfully requested to reconsider. Since the Examiner has not produced a *prima facie* case, Applicants are not obligated to provide evidence of nonobviousness. See M.P.E.P. §2142. Applicants reserve their rights to demand that the Examiner produce a case of *prima facie* obviousness under M.P.E.P. §2142.

Proving a negative is always difficult and sometimes impossible. Having preserved their rights to object under M.P.E.P. §2142 on appeal, Applicants submit that there is evidence of a long-felt but unsatisfied need in the marketplace coupled with a failure by the others to arrive at an invention of the type disclosed and claimed herein.

The rapid changes ushered by the Internet have generated widespread concerns for privacy of personal information. Especially in view of online merchants routinely collecting a user's personal information from web sites, tracking the user's online activities such as purchases, and sharing these data with each other, public outcry resulted in the enactment of privacy laws in several industrialized countries in the world. See Overview of The Privacy Act of 1974, http://www.usdoj.gov/04foia/04_7_1.html, dated May 2000, visited 9/14/2000. More recently, a book published by Professor Jeffrey Rosen of the George Washington University Law School discussed the potential for severe invasion of privacy and the need for new laws to protect misuse of personal information collected by online service providers. See Jeffrey Rosen, The Unwanted Gaze: The Destruction of Privacy in America, Random House Publishers, (May 2000); See also, <http://www.unwantedgaze.com>.

Technological changes have made several things clear. It now appears that there is an inevitability to sharing personal information with others in some manner, and privacy of this information must be ensured. Concerns on information privacy resulted in an International Conference on privacy in Hong Kong in September 13–14, 1999¹.

¹ Applicants learned about this conference on 9/14/2000 while conducting

See <http://www.pco.org.hk/conproceed.html>. Numerous authors presented papers stressing the need for advances in technology as well as in the need to enact new laws to protect privacy. Interestingly, the presently claimed solution to the information privacy problem was not published at this conference. The United States Department of Justice (US DOJ) reported in a document entitled, "Privacy Design Principles for an Integrated Justice System," dated April 5, 2000, retrieved on 9/14/2000 from <http://www.ojp.usdoj.gov/integratedjustice/pdpapril.htm> efforts by a working group---comprising technical and legal experts from the US Department of Justice, US Federal Bureau of Investigation, and Office of the Ontario Information & Privacy Commissioner---outlined general principles and guidelines for the privacy project. Several months later, in a document entitled "Privacy Impact Assessment for Justice Information System: Working Paper", DRAFT, dated July 5, 2000, retrieved on 9/14/2000 from <http://www.ojp.usdoj.gov/integratedjustice/piajis.htm>, this working group published a draft report that described a multi-level secure database for storing personal information. Examiner is requested to note that Messers Paul Kendall, Esquire, Anne Gardner, Esquire, and Dr. Ann Cavoukian, who are listed as contributors to this draft document also co-authored or presented papers at the previously mentioned International Conference in Hong Kong. In view of this evidence, Applicants respectfully submit that the combination of elements as claimed herein, including the particular step of "assigning at least one of a plurality of levels to each information object", would not have been obvious to a person of ordinary skill in the art at the time the instant invention was made.

research in preparation of a response to the Examiner's Final Office Action dated August 18, 2000. Applicants submitted proceedings of this conference to the Patent & Trademark Office in an Information Disclosure Statement dated October 5, 2000.

Claim Rejections under 35 U.S.C. §103(a)
Perry in view of Smith and in further view of Murphy

Examiner rejected claims 7–13 under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Smith as applied to claim 1, and in further view of Murphy (5,644,711). Examiner did not show any reason from the references themselves why such a combination would have been obvious.

In rejecting claim 7, Examiner stated that "claim 7 provides for generating an authorization key, while the Perry patent discloses identifying particular authorized users. The Murphy patent teaches secure access to selected directories using user id and a password, see col. 4, lines 14–38. The teaching of a password implies that an authorizing key is generated by the method."

Murphy is directed toward an art that is very different from Perry. Murphy is directed toward A method and an apparatus for protection of a directory such as those provided by AT&T's WorldWorx Personal Conferencing Service in a wide area network. A directory is protected through a requirement of a valid user identification number and matching password providing access rights to certain secured directory information residing in the wide area network. A user identification number, a matching password and a directory query request are transmitted from a user endpoint such as a personal computer to the wide area network. According to Murphy, once the user identification number and matching password are verified, they enable access to the WorldWorx services, and in particular, to the general purpose directory. In addition, the unique user identification and matching password define which private directories a user has access to. A queried item is located by searching the network databases after the user identification number and matching password are verified for access. The queried item located is then transmitted to the user endpoint if the user identification number and the matching password allow the user access to the specific private directory in the wide area network which contains the queried item. Thus, the Murphy method and apparatus for

multi-privileged directory access to a network for directory information provides for an initial access to the databases containing the directories and a final access to a specific directory if the provided user identification code and matching password allow access to the specific directory or directories.

On the other hand, Perry is directed toward a central depository for important documents, such as living wills (expressing and authorizing the "right to die"), durable powers of attorney and other collateral documents including testamentary wills, authorizations for organ and bone marrow donations, and insurance information.

Why a person skilled in one field would have referred to two different technologies to combine these particular aspects is not shown by the Examiner. As discussed earlier, a motivation to combine references must exist within the references themselves. Absence of such a motivation is dispositive in a determination of obviousness. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F. 3d 1573, 1579, 42 U.S.P.Q. 2d 1378, 1383 (Fed. Cir. 1997). Accordingly, since the independent claim upon which the claims 7–13 depend is patentable, and since a *prima facie* case of obviousness is not shown, claims 7–13 are believed to be patentable. Reconsideration is respectfully requested.

Claim Rejection under 35 U.S.C. §103(a)

Perry in view of Smith and in further view of Moozakis

Examiner rejected claim 17 as obvious under 35 U.S.C. §103(a) based on Perry in view of Smith and in further view of Moozakis. Applicants reassert that Examiner did not produce a *prima facie* case of obviousness. See M.P.E.P. §2143. Applicants hereby incorporate by reference all the arguments traversing the rejection of claim 1 set forth above. Accordingly, in view of the fact that the independent claim upon which claim 17 is dependent is believed to be patentable, claim 17 is also believed to be patentable.

Additionally, Applicants believe claim 17 is patentably distinct in view of the arguments of nonobviousness as stated above, and in further view that Examiner made a general statement that the Internet Printing Protocol was 'efficient' and therefore would have been obvious to a person of ordinary skill to combine the method of creating an online repository and then printing at a prescribed printing device. Examiner has showed no evidence of motivation or suggestion in either Smith, Perry or in Moozakis to make this assertion. Applicants respectfully remind the Examiner that a general motivational statement of efficiency is not sufficient to suggest combinability of references. See Formulating and Communicating Rejections Under 35 U.S.C. §103 for Applications Directed to Computer-Implemented Business Method Inventions, Example 17, available at <<http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm#E17>>.

Reconsideration is respectfully requested.

Claim Rejection under 35 U.S.C. §103(a)

Perry in view of Smith and in further view of Vaudreuil

Examiner rejected claims 18 and 22–23 under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Smith as applied to claim 1, and further in view of Vaudreuil (5,621,727). Applicants traverse this rejection based on the arguments presented in response to the Examiner's rejection of claim 1, and further because Examiner did not show a *prima facie* case of obviousness to combine Perry and Smith with Vaudreuil. Examiner provided a mere conclusion that a person of ordinary skill in the art could secure information requested in Perry with the PEM or public key system as taught by Vaudreuil. Further, Examiner stated that secure requests in an executable form were also disclosed in Vaudreuil, and that this combination would have been obvious under 35 U.S.C. §103(a). Examiner did not provide any evidence to make such an assertion, or to show a combinability of Perry with Vaudreuil.

As stated above, Perry was directed toward a central depository for important documents, such as living wills (expressing and authorizing the "right to die"), durable

powers of attorney and other collateral documents including testamentary wills, authorizations for organ and bone marrow donations, and insurance information. This system is also suited as a repository for related documents such as testamentary wills and authorizations for organ and bone marrow donations as well as information such as health and life insurance.

Vaudreuil, in contrast to Perry, is directed toward a communications system that includes a network hub that is coupled to a messaging system through at least two communication paths. One of the communication paths comprises a public communication path for public messaging traffic to and from the messaging system. The second communication path comprises a private communication path for messaging traffic within a messaging community. The network hub is operable to treat the single messaging system as two virtual messaging systems with each communication path associated with a single virtual messaging system. The network hub comprises translation tables which associate users of the messaging systems with the communities to which they belong and the addresses associated with the users within those communities.

Examiner did not provide any indication of why these two different fields of technology--Perry in the art of creating a central depository for "right to die" documents, and Vaudreuil in the field of an integrated communications system which supplies network-based voice and multimedia communication facilities--could be combined. Applicants respectfully request the Examiner to provide a clear indication of why such a combination would have been obvious. Absent sufficient reason to combine, and since the independent claim upon which dependent claims 18 and 22-23 depend is believed to be patentable, these claims would not have been obvious, and therefore are believed to be allowable.

Conclusion

In view of the foregoing, all pending claims the instant Application are believed to be in a condition for allowance. Reconsideration and an early Notice of Allowance are respectfully requested. A check for \$793 is enclosed to cover the filing fees for all claims including nine newly added claims.

Respectfully Submitted,

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